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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,686	07/23/2003	Takashi Fujikado	116402	6681
25944	7590	12/16/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			BOCKELMAN, MARK	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/624,686	FUJIKADO ET AL.
	Examiner Mark W Bockelman	Art Unit 3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-25-2003, 3-18-2004</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant recites a plurality of electrodes that are placed on the outside of a choroid of a patient's eye which thus includes a patient's eye as part of the invention. As noted in the attached memo from former commissioner Quigg, claiming any part of a patient that includes within it's scope human beings is regarded as nonstatutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by

Tassicker teaches an implantable device having a photoreactive material which having a metal portion associated with it for developing potentials which are applied to cells for stimulation. Since the crystal structure offers resolution, the examiner considers the corresponding metal associated with each "pixel" to be an electrode. Tassicker

teaches placing the stimulating member between the choroids and sclera (see column 1 lines 39-41).

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being a by Chow et al. USPN 6,427,087. Chow teaches the placement of a stimulating array of electrodes and a ground electrode on opposite sides of the retina. In one embodiment the stimulation array is taught as being placed between the choroids and the sclera of the eye see claim 34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ok et al. US 2002/0095193 (alone or alternatively in view of Chow et al USPN 6,427,087 or Tassicker USPN 2,760,483).

Since the phrase "outside the choroid" may be interpreted in several ways several alternative rejections are applied. First Oak shows an electrode array (22) that is placed in the vitreous space which is considered outside the surface of the retina and choroids surface as opposed to be placed inside the layers of the eyeball. In this respect Ok et al. teach a photographing means (12, 30), conversion means (32) transmitting means (34, 36 and 16), receiving means 28 which receives power from the transmitted signal. Alternatively, if read in light of applicant's specification and claim 2,

to have provided the electrode array of Ok between the sclera and choroid would have been an obvious alternative placement.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ok et al. US 2002/0095193 (alone or alternatively in view of Chow et al USPN 6,427,087 or Tassicker USPN 2,760,483) as applied to claims 1, 3-5 above. While Ok et al. is silent to have a battery in his camera and image processor it is apparent that such a power source may be used.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ok et al. US 2002/0095193 in view of Chow et al USPN 6,427,087 or Tassicker USPN 2,760,483. To have place the electrode array of Ok et al. between the choroids and the sclera would have been obvious with can member 60 serving a ground electrode or other ground electrode used to obtain the benefits taught by Chow et al.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ok et al. US 2002/0095193 (alone or alternatively in view of Chow et al USPN 6,427,087 or Tassicker USPN 2,760,483) as applied to claims 1, 2-5 above, and further in view of WO 00/56393 to Greenberg. To have used notched electrodes such as figure d in Greenberg would have been an obvious choice of electrode configuration.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ok et al. US 2002/0095193 (alone or alternatively in view of Chow et al USPN 6,427,087 or Tassicker USPN 2,760,483) as applied to claims 1, 3-5 above, and further in view of Walter et al "Evoked cortical potentials after electrical stimulation of the inner retina in rabbits". To have used current densities for providing stimulation in the recited range of applicant's claim 8 would have been obvious in view of Walter et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272 -4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

December 11, 2004


MARK BOCKELMAN
PRIMARY EXAMINER